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09/641,030	08/17/2000	Leanne M. Capozzi	81503F-P	4827

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EASTMAN KODAK COMPANY
PATENT LEGAL STAFF
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ROCHESTER, NY 14650-2201

EXAMINER

WILLIAMS, JAMILA O

ART UNIT	PAPER NUMBER
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3722

MAIL DATE	DELIVERY MODE
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12/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/641,030

Applicant(s)

CAPOZZI ET AL.

Examiner

Jamila Williams

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-23 and 53-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-23,53-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,9-11,21,23,53,54 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,674,923 to Shih et al (hereinafter Shih).

Shih discloses a kit for organizing a plurality of images provided by a customer on a plurality of hard copy prints comprising a plurality of labels each having machine readable code to identify a separate category of customer provided hard copy images (hard copy prints and labels with machine readable code 30-see figures 3-4 and see column 7 lines 7-15, which indicates having a plurality of prints and labels). Shih discloses having a envelope encompassing instructions and order information having machine readable code to associated with a separate label and to provide information to each customer provided hard copy image associated with the separate label, the instruction forms being associated with a unique order instruction and having machine readable instructions to associate one or more separate category of customer provided hard copy images with at least one good or service and for ordering at least one good or service (column 6 lines 36-45). The examiner takes the position that this envelope having instructions and order information constitutes an order form and instruction form. And in that the system is for producing hard copy prints, it would have been obvious to

one having ordinary skill in the art at the time the invention was made to provide multiple envelopes (with order information and instructions thereon) such that multiple rolls of film can be processed and multiple sets of hard copies would therefore be provided). This modification would satisfy the limitation of having a plurality of instruction forms as recited in claim 1.

Alternatively, Shih discloses in column 9 lines 16-31 having a card with instructional information thereon such that the hard copies can be provided to a third party once completed by the photofinisher. This card can also be considered an instruction form. In that the system is for producing hard copy prints, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide multiple hard copy prints and instruction card (instruction forms) to a third party for use thereby. This modification also satisfies the limitation of having a plurality of instruction forms as recited in claim 1.

Regarding claims 2-3, Shih discloses instructions for the customer on how to use the kit and the instructions provided on a hard copy print (column 5 lines 10-16). It is noted that the teaching of instructions is in association with figure 6-7 for example. however it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teaching of having instructional information on the hard copy of figure 6 in the embodiment of figure 3-4 for the purpose of providing the user with instructions of using the kit.

Regarding claim 4, Shih discloses the instructions are provided in visual format (figure 7).

Regarding claim 9, Shih discloses that the instruction form provides instruction to the photofinisher to include information 18 on the hard copy (column 6 lines 40-45) and column 3 lines 42-61 discloses the information 18 includes metadata from the order form or roll of film, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include metadata on the instruction form as well as the order form for the purpose of providing uniform instructions and information to the user.

Regarding claim 10, Shih discloses the plurality of instruction forms includes a human readable order instruction, which corresponds to machine readable code (column 6 lines 36-45).

Regarding claims 11 and 21, Shih discloses all elements of the claims including having machine readable code. Shih does not however disclose the machine readable code is in the form of an icon or color, however it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the machine readable code of Shih in the form of an icon or color as suited for the intended use and as a matter of design choice.

Regarding claim 23, wherein the instruction forms have a size substantially the same as the size of the hard copy prints. It would have been an obvious matter of design choice to alter the size as claimed, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Regarding claim 53, Shih discloses having a kiosk (100) with an appropriate reading device to read the barcode of the hard print (column 8 lines 43-44), this would inherently include the metadata that is provided thereon (as disclosed in column 3 lines 41-51).

Regarding claim 54, Shih discloses the plurality of labels, plurality of instruction forms, at least one order form as applied to claim 1 above. Regarding the limitation towards the instruction forms comprising meta data to be applied to the images, see rejection of claim 9 above.

Claims 5-7, 12-14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shih in view of 4,730,727 to Petroff. Shih discloses all elements of the claims but for a holder and the holder including pockets or envelopes.

Petroff teaches having a holder with pockets or envelopes (figure 11 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the holder with pockets or envelopes as taught by Petroff with the kit of Shih for the purpose of organizing the hard prints and forms.

Regarding claims 12-13, Shih modified by Petroff discloses the kit comprises a container (figure 11), the container provided with at least one section for holding images provided in other formats (any one of the pockets or envelopes of Petroff can be considered the at least one section claimed).

Regarding claim 14, Shih modified by Petroff discloses the at least one section is designed to hold any one of the claimed image formats (the pockets or envelopes of

Petroll are inherently capable of holding any one of the claimed formats, column 4 lines 24-25, discloses the use of the device with computer disk).

Regarding claim 16, Shih modified by Petroff discloses a holder having a plurality of pockets for categorizing images (figure 11- the holder with pockets of Petroff is inherently capable of being used to categorize images)

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shih in view of 4,730,727 to Petroff and further in view of 5,906,397 to MacWilliams et al (hereinafter MacWilliams).

Shih modified by Petroff discloses all elements of the claims but for the pair of identical labels for the pocket and hard copy prints.

MacWilliams teaches having a filing system having labels for associating a pocket (or file envelope) with the documents stored therein (see abstract and column 3 lines 25-40 of MacWilliams). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the paired labels of MacWilliams with the pockets and hard copy prints as taught by Shih and Petroff for the purpose of organizing the pockets and images.

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shih in 4,057,923 to Chase. Shih discloses all elements of the claims but for the claimed carrier.

Chase discloses a carrier for holding an image (figure 9), as recited in claim 17. In that the structure is met by the carrier of Chase, it is presumed to be inherently capable of allowing for feeding and scanning as claimed.

Chase discloses the carrier comprises a support surface with an adhesive layer for holding the image (adhesive A), as recited in claim 18.

Chase discloses the carrier further includes alignment marks for assisting in positioning the image (guide lines G), as recited in claim 19 a retaining member located at one end of the carrier to securely hold the print (the upper area of adhesive EA in figure 9 for example), as recited in claim 20.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the carrier of Chase with the kit of Shih for the purpose of mounting the images.

Claims 21 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shih in view of Re. 26,663 to Dwyer, Jr. Shih discloses the plurality of labels, plurality of instruction forms, at least one order form as applied to claim 1 above. Shih does not however disclose a tool for use in determining the number of images to be scanned.

Dwyer, Jr teaches a tool (31) having a scale (38) for determining the number of sheets contained therein. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the tool of Dwyer, Jr with the kit of Shih for the purpose of determining the number of images.

Response to Arguments

Applicant's arguments with respect to the claims and the applied art have been considered but are not persuasive.

Regarding applicant's argument that 6,674,923 is not prior art to the instant application, the examiner respectfully disagrees. '923 has a filing date of 3-28-2000 and the instant application has a filing date of 8-17-2000. Based on the earlier effective U.S. filing date of reference ('923) it constitutes prior art under 35 U.S.C. 102 (e). Additionally according to 706.02(f) where there are joint inventors, only one inventor need to be different for the inventive entity to be different and a rejection under 35 U.S.C. 102(e) is applicable even if there are some inventors in common between the application and reference.

Also under 102(f) it cannot be determined which inventive entity is the owner of the subject matter sought to be patented in the instant application.

The rejections of record are therefore maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

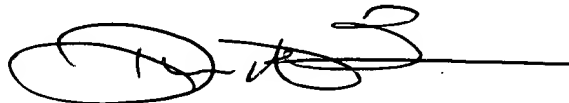
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JW 12-10-2007



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